REMARKS/ARGUMENTS

The Examiner is thanked for the clarity and conciseness of the previous Office Action, and for the citation of references, which have been studied with interest and care.

This Amendment is in response to the Office Action mailed November 30, 2004. In the Office Action, claims 1, 3-12, 14-23, and 25-33 stand rejected under 35 U.S.C. § 103(a).

Applicant respectfully submits that the case is now in condition for allowance or in better form for appeal.

Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 1, 3-12, 14-23, and 25-33 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No 6,317,222 issued to Jacobi et al. (herinafter Jacobi) in view of U.S. Patent No. 6,125,353 issued to Yagasaki (hereinafter Yagasaki).

Applicant respectfully submits that independent claims 1, 12, and 23 are not rendered obvious by the combination of Jacobi and Yagasaki because Jacobi and Yagasaki are not properly combinable.

Particularly, Jacobi is not properly combinable with Yagasaki because Jacoboi *teaches away* from Applicant's claim limitations of independent claims 1, 12, and 23, and further, the intended function of Jacobi would be destroyed by this combination. Therefore, there is no motivation to combine Jacobi with Yagasaki.

Further, even if Jacobi and Yagasaki were properly combinable, their combination would still not teach the limitations of Applicant's independent claims 1, 12, and 23.

Applicant's independent claims 1, 12, and 23 generally relate to: *upon a user logging onto a virtual store having a virtual browser via a computer network, displaying a random assortment of products to the user associated with the virtual store without regard to a user profile*...creating a plurality of categories, each category identifying an attribute...associating

products having at least one attribute with at least one category...and upon selection of a main product by a user in communication with the visual browser, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user.

Applicant respectfully submits that Jacobi *teaches away* from displaying a random assortment of products to the user associated with the virtual store ***without regard to a user profile.***

With regards to obviousness, as aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

> Most if not all inventions arise from a combination of old elements. Thus every element of a claimed invention may often be found in the prior art. *However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. (Emphasis added).

Further, references are not combinable when one of the references *teaches away* from the invention as set forth in the claims. As will be discussed, Jacobi teaches away from Applicant's claim limitations. As stated in the MPEP [i] t. is improper to combine references where the references *teach away* from their combination" MPEP § 2145 (emphasis added).

As further set forth in the MPEP:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)
>
> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Applicant respectfully submits that Jacobi and Yagasaki are not combinable because Jacobi *teaches away* from their combination and, in fact, the proposed modification of Jacobi would destroy the intended function and purpose of Jacobi.

As set forth in MPEP § 2145.X.D and 2143.01, when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of obviousness cannot be properly made. This has consistently been held by the Federal Circuit.

Quite clearly, Jacobi *teaches away* from the limitations of Applicant's independent claims 1, 12, and 23 that recite upon a user logging on to a virtual store having a virtual browser via computer network, a random assortment of products are displayed to the user associated with the virtual store *without regard to a user profile*.

Moreover, combining Jacobi with Yagasaki in an attempt to teach Applicant's claim limitations *would destroy the intended function and purpose* of Jacobi.

Jacobi teaches a service that recommends products or other items to a user based on a set of items known to be of interest to the user, such as a set of items currently in the user's electronic shopping cart. In fact, Jacobi's function and purpose is aptly described in its title: "use of Electronic Shopping Carts to Generate Personal Recommendations." The very function and purpose of Jacobi to provide an improved recommendation system based upon products that are known to be of interest to the user, would be completely destroyed, if it were to be combined with Yagasaki to try to render Applicant's claims obvious.

Accordingly, Applicant respectfully submits that it is clear that because Jacobi *teaches away* from a combination with Yagasaki, and because a combination with Yagasaki would destroy Jacobi's intended purpose and function, that there is quite simply no motivation to combine Jacobi with Yagasaki. Therefore a prima facie case of obviousness has not been properly made.

Because as the Office Action states, Jacobi does not teach upon a user logging on to a virtual store having a virtual browser via a computer network, and displaying a random

assortment of products to the user associated with the virtual store without regard to a user profile (Office Action, page 3), independent claims 1, 12, and 23 are patentable and should be allowed.

Further, Applicant respectfully submits that, in fact, the very purpose for which Yagasaki is set forth by the Office Action, to allegedly teach displaying a *random assortment of products* to the user associated with the virtual store without regard to a user profile is inaccurate. Yagasaki does not actually teach these limitations.

The Office Action cites various sections of Yagasaki for this teaching. However, looking particularly at one of these citations, column 1, lines 29-40, illustrates that Yagasaki teaches a product search screen which when opened by a customer presents a list of product categories such as "fashion," "gourmet," "hobby," "holiday season," and "gifts," which are listed as available search keys. As set forth in Yagasaki: "From this list, the customer selects one category that may include what he/she desires to buy...products that fall under the selected category are then displayed on the screen of a customer's terminal." (emphasis added).

Thus, as set forth above, Yagasaki teaches displaying product categories that may then be searched for particular products. Accordingly, Jacobi does not teach *displaying a random assortment of products upon a user logging on to a virtual store*, but only displaying a list of product categories that are then searchable.

Yagasaki does not teach displaying a random assortment of products to the user associated with the virtual store without regard to a user profile when the user logs on to the virtual store.

Thus, as previously discussed in detail, Jacobi is not properly combinable with Yagasaki, because Jacobi *teaches away* from a combination with Yagasaki and, further, the combination of Jacobi and Yagasaki would destroy *the intended function and purpose* of Jacobi. Moreover, as previously discussed, even if Jacobi and Yagasaki were combinable, their combination would still not teach or suggest the claim limitations of Applicant's independent claims 1, 12, and 23.

Accordingly, Applicant respectfully requests that Applicant's independent claims 1, 12, and 23 be allowed and moved to issuance. Further, Applicant's dependent claims are allowable for being dependent upon allowable base claims.

Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1, 3-12, 14-23, and 25-33 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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